

Remarks

Claims 1-19 are pending. The present Amendment amends the specification at pages 3 and 4 to correct an obvious spelling error, amends claims 1, 3, 6 and 7, and adds new claims 15-19. No new matter has been added by the present Amendment. Reconsideration of the above-identified application in view of the present Amendment is respectfully requested.

Applicant wishes to thank the Examiner for the courtesies extended during the interview earlier this month. Applicant believes the interview was most helpful in advancing prosecution of the application.

Claims 3, 6 and 7 were objected to because of a misspelling. The claims have been amended to correct the misspelling. Likewise, the specification has been amended to correct the misspelling. Accordingly, Applicant respectfully requests withdrawal of the objection.

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended claims 1, 6 and 7 to overcome the indefiniteness objection. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112 rejection.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,491,540 to Barreca, hereinafter "*Barreca*," in view of WO 01/015356 to Brink, hereinafter "*WO '356*," and U.S. Patent No. 5,817,329 to Gardiner, hereinafter "*Gardiner*." Applicant respectfully traverses this rejection.

Claim 1 recites a lollipop comprising Guarana PE 22 %, hydroxycitric acid, and L-Tyrosine.

The law is clear that a patent is to be granted unless the Examiner can establish that the invention would have obvious at the time it was made. The Examiner fails this burden. The suggestion to combine the references, required by the law, is missing.

The Examiner has not established the requisite motivation to combine the references. The Examiner acknowledges that none of the three cited references, alone, disclose, teach or suggest the present invention. Notably, the Examiner states that: "Applicant's claims are drawn to a lollipop composition containing Guarana PE 22%, CitriMax®, and L-Tyrosine." (Office Action at paragraph 8.) Thus, Applicant's claims are drawn to a lollipop composition containing three separate components. Notably, the Examiner combined three separate references to make the rejection. In doing so, the Examiner stated that: "A person of ordinary skill in the art would reasonably expect that hydroxycitric acid and tyrosine could advantageously be used in the weight loss lollipop-containing Guarana taught by US '540. Motivation for such combination flows logically from there having been used individually in the prior art for the same purpose. (See MPEP § 2114.06.)" Applicant, however, respectfully disagrees with these assertions. No motivation exists in the prior art to combine the references in the manner suggested by the Examiner.

To begin with, Applicant invites the Examiner to read *In re Geiger*, 2 USPQ 2d 1276 (Fed. Cir. 1987)¹, which contradicts the notion that motivation exists for combining components used individually for the same purpose. In the *Geiger* case, in finding that the Patent Office did not present a *prima facie* case of obviousness, the Federal Circuit held that motivation for such a combination had to be found in the prior art.

The *Geiger* case is consistent with the law requiring that there be some teaching, suggestion, or motivation to combine the cited references. *In Rouffet*, 47 USPQ 2d, 1453, 1456 (Fed. Cir. 1998). The requirement is to prevent Examiner's from impermissibly engaging in hindsight to evaluate the invention:

¹ Copies of the cited cases are provided herewith for the Examiner's convenience.

If identification of each claimed element in the prior art were sufficient to negate patent ability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements, would permit an Examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patent ability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patent ability.”

(*Rouffet*, 47 USPQ 2d, 1457, quoting *Sensonics, Inc. v. Aerosonic Corp.*, 38 USPQ 2d, 1551, 1554 (Fed. Cir. 1996) (Emphasis added.).

The requisite motivation to combine the references in the prior art is not present. In the case of *In re Anita Dembiczak and Benson Zinbarg*, 50 USPQ 2d, 1614 (Fed. Cir. 1999), the CAFC has indicated that the requirements for showing the teaching or motivation to combine references is “rigorous.” *Dembiczak* at 1617. Moreover, this showing, which is rigorously required, must be “clear and particular.” *Dembiczak* at 1617. See also, *C.R. Bard v. M3 Sys., Inc.*, 48 USPQ 2d, 1225, 1232 (Fed. Cir. 1998). It is well established that merely because references can be combined, the mere suitability for logical combination does not provide motivation for the combination. See, *Berghauser v. Dann*, Comr. Pats., 204 USPQ 398 (DCDC 1979); *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984). Moreover, mere conclusory statements supporting the proposed combination, standing alone, are not “evidence.” *McElmurry v. Arkansas Power and Light Co.*, 27 USPQ 2d, 1129, 1131 (Fed. Cir. 1993).

The Examiner has failed to show the requisite motivation to combine the references because none exist. *Barreca* is directed to a center-filled lollipop. At best, *Barreca* discloses a center-filled lollipop that has between 0.05 mg to 30 mg of Guarana. Notably, the amount of Guarana recited in claims 6 and 7 are appreciably higher than the amounts disclosed in *Barreca*. In addition to identifying Guarana, *Barreca* identifies a myriad of other components that can be included in the gum cavity. Not one of these other components is hydroxycitric acid, L-Tyrosine, or any of the other components recited in Applicant’s disclosure.

Moreover, as noted by the Examiner, *Barreca* does not even disclose the specific type of Guarana recited in claim 1. To overcome this deficiency, the Examiner states that since the *Gardiner* reference teaches the use of a Guarana extract containing 22% caffeine, a person would be motivated to modify the lollipop composition taught by the combination of US '540 and WO '356 to include Guarana with 22% caffeine. There is no suggestion, however, in either of *Barreca* or *Gardiner* that Guarana PE 22% could be usable in a gum cavity.

In addition to the *Barreca* reference not disclosing, teaching or suggesting the use of Guarana PE 22%, *Barreca* does not disclose, teach or suggest the use of CitriMax® or L-Tyrosine. To overcome this deficiency, the Examiner looks to WO '356. However, WO '356 discloses a very specific weight control product comprising a synergistic mixture of guggul extract, phosphate salts and metabolic stimulant. Notably, the title of the WO '356 reference indicates that the mixture is synergistic. The WO '356 reference only discloses that hydroxycitric acid and L-Tyrosine, when used in the amounts disclosed in the WO '356 reference and with the other ingredients disclosed in the WO '356 reference, can be used as a weight control product. Nowhere in the WO '356 reference does it state that hydroxycitric acid or L-Tyrosine are useful as weight control products with other components not listed in the WO '356 patent, let alone with Guarana and/or Guarana PE 22%. Applicant discovered this combination.

In essence, the Examiner combined the broad teaching of *Barreca*, which broadly discloses the use of Guarana in a lollipop cavity, with two of several ingredients mentioned in the very specific synergistic mixture of WO '356, and selected to use a specific Guarana that is disclosed in a very specific weight gaining composition disclosed in *Gardiner* to reject the present invention. To pick and choose specific claim components from three separate references and to modify specific components of these same references without any suggestion from any of the references appears to be a classic case of using the Applicant's own disclosure against them. This seems opposite to the required rigorous showing in the prior art of motivation to combine the references.

Furthermore, the Applicant's invention has been met with great commercial success. Applicant has been selling \$70,000-\$100,000 worth of their lollipops each month, with over six million of their lollipops sold to date. Furthermore, Applicant wishes to submit the attached testimonials showing the success the lollipops have had. (See Exhibits 1-6).

Accordingly, Applicant respectfully submits that the proposed combination is improper and the rejection should be withdrawn.

Claims 2-7 all depend either directly or indirectly from independent claim 1 and are therefore patentable for at least the same reasons as independent claim 1. Moreover, add further limitations which better define the invention and render them separately allowable.

For instance, claims 2 and 3 further recite that the composition comprises Vitamin B6 and further Vitamin B12. To overcome the deficiency in the rejection based upon the three combined references, the Examiner looks to yet another reference (U.S. Patent No. 5,968,544 to Howard) hereinafter, "*Howard*" and asserts that this forth reference teaches adding Vitamins B6 and B12 to the lollipop composition of US '540, WO '356, and US '329 because a person of ordinary skill in the art would reasonably expect that adding these two Vitamins to the lollipop composition would be beneficial to the health of the individual using the lollipop. This belief that adding Vitamins B6 and B12 to the lollipop composition would be beneficial to the health of the individuals using the lollipop is based upon the fact that Vitamins B6 and B12 are disclosed in the *Howard* reference to be beneficial to compositions containing Creatine for weight gain. Applicant fails to understand how weight gain can disclose, teach or suggest modifications to weight loss compositions. Accordingly, Applicant respectfully submits that claims 2 and 3 are allowable.

Moreover, claims 6 and 7 recite specific compositions that are not disclosed, taught or suggested by any combination of the four cited references. Notably, no reference discloses the use of Guarana PE 22% in such high amounts. Accordingly, claims 6 and 7 are patentable.

New claims 15-19 have been added. None of the prior art discloses, teaches or suggests the limitations of these claims.

Claim 15 recites a lollipop consisting essentially of:

CONSTITUENT	RANGES
Guarana PE 22 %	220 - 660 mg
Hydroxycitric acid	100 - 400 mg
L-Tyrosine	100 - 400 mg
Vitamin B6	300 mcg - 2 mg
Vitamin B12 Cyanocobalamin	0.540 mcg - 6.000 mg
Corn syrup	3 grams - 15 grams
Maltodextrin	120 - 200 mg

Nowhere in the prior art are the limitations of claim 15 disclosed, taught, or suggested. Thus, claim 15 is patentable.

Claim 16 recites a lollipop consisting essentially of:

CONSTITUENT	AMOUNT
Guarana PE 22 %	440 mg
Hydroxycitric acid	200 mg
L-Tyrosine	200 mg
Vitamin B6	400 mcg
Vitamin B12 Cyanocobalamin	0.600 mcg
Corn syrup	7 grams
Maltodextrin	160 mg

Nowhere in the prior art are the limitations of claim 16 disclosed, taught, or suggested. Thus, claim 16 is patentable.

Claim 17 recites the lollipop of claim 16 wherein the components comprise a substantially homogeneous composition.

Nowhere in the prior art are the limitations of claim 17 disclosed, taught, or suggested. Thus, claim 17 is patentable.

Claim 18 recites a lollipop consisting of:

CONSTITUENT	RANGES
Guarana PE 22 %	220 - 660 mg
Hydroxycitric acid	100 - 400 mg
L-Tyrosine	100 - 400 mg
Vitamin B6	300 mcg - 2 mg
Vitamin B12 Cyanocobalamin	0.540 mcg - 6.000 mg
Corn syrup	3 grams - 15 grams
Maltodextrin	120 - 200 mg

Nowhere in the prior art are the limitations of claim 18 disclosed, taught, or suggested. Thus, claim 18 is patentable.

Claim 19 recites a lollipop consisting of:

CONSTITUENT	RANGES
Guarana PE 22%	220 - 660 mg
Hydroxycitric acid	100 - 400 mg
L-Tyrosine	100 - 400 mg
Vitamin B6	300 mcg - 2 mg
Vitamin B12 Cyanocobalamin	0.540 mcg - 6.000 mg
Corn syrup	3 grams - 15 grams
Maltodextrin	120 - 200 mg

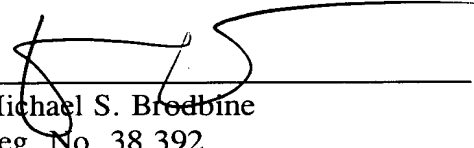
Nowhere in the prior art are the limitations of claim 19 disclosed, taught, or suggested. Thus, claim 19 is patentable.

Applicant submits that the application is in a condition for allowance and respectfully request a notice to that effect. If the Examiner believes that a telephone conference will advance the prosecution of this application, such a conference is highly encouraged at the convenience of the Examiner.

A check in the amount of \$60.00 is enclosed to cover the one month Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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